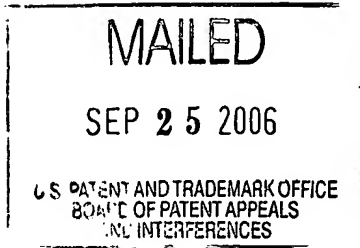


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte PAUL SHIRLEY
and
CRAIG HICKMAN

Application No. 10/777,957

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on September 15, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Issues

In the Examiner's Final rejection mailed on June 2, 2005, the Examiner entered the following grounds of rejection:

(a) claims 34-39 and 55-62 under 35 U.S.C. § 103(a) as being

unpatentable over Shuji (JP10-294261, properly identified in Examiner's Answer of 04/18/06 as "Akune"), in view of Maeda et al. (U.S. 5,330,557, hereinafter "Maeda");

(b) claims 40-41 under § 103 as being unpatentable over Shuji in view of Maeda, as applied to claims 33-39 and 55-62 above, further in view of Su et al. (U.S. 5,507,874, hereinafter "Su"); and

(c) claim 42 under § 103 over Shuji in view of Maeda, as applied to claims 33-39 and 55-62 above, further in view of Satterfield et al. (U.S. 5,364,144, hereinafter "Satterfield").

A review of the Examiner's Answer mailed on April 18, 2006 reveals inconsistencies in the rejection of claims on appeal. For example, the Examiner relies upon the reference of Sada (U.S. 6,062,240) in his rejection of claims on appeal. Since this reference was not introduced in the Examiner's Final rejection of June 2, 2005, the Board considers this a new ground of rejection.

According to the Manual of Patent Examining (MPEP) § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory

approval in order to reopen prosecution.

In addition, any new ground of rejection made by an Examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

Conclusion

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- (1) vacate the Examiner's Answer mailed April 18, 2006;
 - (2) rewrite the Examiner's Answer without the new grounds of rejection, or
- to obtain approval from a TC Director or appropriate designee; and
- (3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:

A handwritten signature in black ink, appearing to read 'D. M. Shaw', followed by a long horizontal line extending to the right.

DALE M. SHAW

Deputy Chief Appeal Administrator
(571) 272-9797

Application No. 10/823,379

clj

cc: Schwegman, Lundberg, Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402-0938

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
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Application No. 10/777,957

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This application was electronically received at the Board of Patent Appeals and Interferences on September 15, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Background

On June 2, 2005, the Examiner entered a Final rejection.

On February 8, 2006, Appellants filed an Appeal Brief.

On April 18, 2006, the Examiner mailed an Examiner's Answer in response

to Appellants' Brief.

Issues

In the Examiner's Final rejection mailed on June 2, 2005, the Examiner entered the following grounds of rejection:

(a) claims 34-39 and 55-62 under 35 U.S.C. § 103(a) as being unpatentable over Shuji (JP10-294261, properly identified in Examiner's Answer of 04/18/06 as "Akune"), in view of Maeda et al. (U.S. 5,330,557, hereinafter "Maeda");

(b) claims 40-41 under § 103 as being unpatentable over Shuji in view of Maeda, as applied to claims 33-39 and 55-62 above, further in view of Su et al. (U.S. 5,507,874, hereinafter "Su"); and

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A review of the Examiner's Answer mailed on April 18, 2006 reveals inconsistencies in the rejection of claims on appeal. For example, the Examiner relies upon the reference of Sada (U.S. 6,062,240) in his rejection of claims on appeal. Since this reference was not introduced in the Examiner's Final rejection of

June 2, 2005, the Board considers this a new ground of rejection.

According to the Manual of Patent Examining (MPEP) § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

In addition, any new ground of rejection made by an Examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

Conclusion

Accordingly, it is

ORDERED that the application is returned to the examiner to either:

(1) reopen prosecution to address the new ground of rejection, or

Application No. 10/823,379

- (2) to obtain approval from a TC Director or appropriate designee; and
- (3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: _____
DALE M. SHAW
Deputy Chief Appeal Administrator
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